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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/781,908

02/20/2004

Ichiro Kawase

Q80007

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65565 7590 12/22/2006
SUGHRUE-265550
2100 PENNSYLVANIA AVE. NW
WASHINGTON, DC 20037-3213

EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/22/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/781,908

Applicant(s)

KAWASE ET AL.

Examiner

Melissa S. Mercier

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9-15-04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Summary

Receipt of the Information Disclosure Statement filed on September 15, 2004 is acknowledged. Claims 1-5 are pending in this application. Claims 1-5 are rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 rejected under 35 U.S.C. 102(b) as being anticipated by Kamishita et al. (US Patent 6,017,920).

Kamishita discloses an antifungal composition for external use. The composition comprises an antifungal agent having a high affinity for keratin; neticonazole is disclosed for use (column 2, lines 33-34). Kamishita further discloses in the preparation of a gel comprising a water-soluble basic compound (diisopropanolamine) is used (Example 12).

Regarding Claim 3, surfactants including lauromacrogol and polyoxyl 40 stearate are disclosed as additional components (column 3, lines 7-9).

Regarding Claim 4, Kamishita discloses oily liquid substances are included in the composition (abstract).

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Regarding Claim 5, Kamishita discloses, the antifungal composition can be "formulated into an ointment, cream, gel, gel cream, lotion, or solution" (column 2, lines 59-62).

Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Since the instantly claimed invention is taught in its totality in the prior art references of Kamishita, it is the examiners position that the pH of the composition would be an inherent property of the composition.

Furthermore, the recitation of an "external preparation for the nail" is interpreted as intended use of the composition and is given no patentable weight.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Murata et al. (EP 0 445 540).

Murata discloses an "antimycotic external imidazole preparation, comprising (E)-1-[2-methylthio-1-[2-(pentyloxy)phenyl]ethenyl]-1H-imidazole hydrochloride; which applicant has identified as the chemical name of neticonazole hydrochloride on page 2 of the instant specification. The composition disclosed by Murata further comprises a basic substance (abstract).

Regarding Claim 3, Murata further discloses it is advantageous to use a base with contains a non-ionic surfactant (page 3, lines 30-31).

Regarding Claims 4-5, Murata discloses when formed in a ointment or cream preparation, a liquid oil substance is added (page 2, lines 47-48).

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Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Since the instantly claimed invention is taught in its totality in the prior art references of Murata, it is the examiners position that the pH of the composition would be an inherent property of the composition.

Furthermore, the recitation of an "external preparation for the nail" is interpreted as intended use of the composition and is given no patentable weight.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chew et al. (US Patent 7,094,422).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

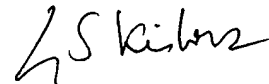
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MSMercier



Gollamudi S. Kishore, PhD
Primary Examiner
Group 1600